

REMARKSSTATUS OF CLAIMS

The Office Action dated September 9, 2003 has been received and its contents carefully considered. Claims 2-26 are pending. Claims 23 and 26 are independent.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

OFFICE ACTION

Claims 2-5, 7-10, 18-24 and 26 were rejected under 35 U.S.C. §102(b) as being anticipated by Klein et al. '998. Claims 6, 15-17 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Klein et al. '998. Claims 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Klein et al. '998 in view of Barnes '082. These rejections are respectfully traversed with respect to the following reasons.

CLAIM REJECTIONS – 35 U.S.C. § 102(b)

Initially, Applicants note that it is axiomatic that to qualify as an anticipation under Section 102, the cited reference must “bear within its four corners adequate directions for the practice of the patent invalidated.” (See, for example, Dewey & Almay Chemical Co. v. Mimex Co., Inc., 52 U.S. P.Q. 138 (2nd Cir. 1942)). Applicant respectfully submits that Klein et al. '998 embodies no such directions.

More particularly, Applicants respectfully submit that Klein et al. 998 does not disclose a first superconducting magnetic bearing or a passive first superconducting magnet stator. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found

either expressly or inherently described as required by the M.P.E.P, Klein et al. '998 cannot be said to anticipate a first superconducting magnetic bearing or a passive first superconducting magnet stator of the present invention as claimed.

Examiner states that Klein et al. '998 shows a first superconducting magnetic bearing (6) and a first superconducting magnet stator (21). However, Klein et al. '998 teaches away from using a superconducting magnetic bearing or a superconducting magnet stator. Klein et al. '998 teaches using a magnet rotor made of ALNICO (col. 2, lines 20-24), an aluminum-nickel-cobalt alloy or the like which is incapable of being superconducting based on its properties.

Superconductors are substances that conduct electricity very efficiently (*i.e.*, with little to no resistance) at low temperatures and are usually nonstoichiometric compounds by definition.

Applicants claim an apparatus that includes a superconducting magnetic bearing and a superconducting magnet stator as clearly described throughout the specification. Thus, Klein et al. '998 cannot be said to teach or suggest the invention as presently claimed.

In light of the foregoing arguments, withdrawal of the rejection of claims 23 and 26 under 35 U.S.C. § 102(b) as being anticipated by Klein et al. '998 is respectfully requested.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *MPEP* §2142. To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142. In light of the argument regarding the Klein et al. '998 reference, the combined references do not teach or suggest all the claim limitations of the present application.

Applicants respectfully point to the final prong of the test, which states the prior art must teach all the claim limitations. At the very least, the combined references do not teach all of the limitations of independent claims 23 and 26 because of the arguments set forth regarding Klein et al. '998 in the anticipation section of this response.

Additionally, Applicants note that the Examiner has cited Barnes '082 to reject those claims that include a cryogenic unit. Barnes' 082 describes a disk drive utilizing a superconducting material to improve efficiency of a bearing support. In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Thus, Klein et al. '998 taken alone or in view of Barnes '082 cannot be said to teach or suggest a superconducting magnetic bearing or a superconducting magnet stator as presently claimed.

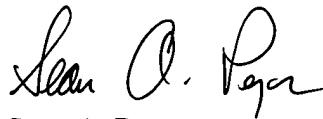
For the foregoing reasons, it is respectfully submitted that the invention recited in claims 23 and 26 is patentable over Klein et al. '998 taken alone or in combination with Barnes '082. Thus, it is respectfully submitted that the remaining depending claims are allowable for at least the reasons given herein.

In view of the foregoing, reconsideration and allowance of the application are believed in order, and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned at 202/861-1748.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read "Sean A. Pryor". The signature is fluid and cursive, with the first name "Sean" and last name "Pryor" clearly distinguishable.

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